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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/219,935	12/23/98	BROWSE	J BB-1036-B

023906 HM22/0213  
E I DU PONT DE NEMOURS AND COMPANY  
LEGAL DEPARTMENT - PATENTS  
1007 MARKET STREET  
WILMINGTON DE 19898

EXAMINER

MCCELWAIN, E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/13/01

*18*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/219,935

Applicant(s)

BROWSE ET AL.

Examiner

Elizabeth McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1 and 21-24, 26-28 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1638.

5 Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on November 16, 2000 has been entered.

Claim 25 remains withdrawn from consideration in view of the election of Group I in Paper No. 5.

10 Claims 29-33 are newly submitted.

Claims 1 and 24 are newly amended.

Claims 1 and 20-33 are pending.

Claims 1, 20-24 and 26-33 are examined on the merits.

15 The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 27 and 28 are objected to for depending upon claim 25, which is withdrawn from consideration and which does not have antecedent basis for a method. Correction is required.

20 Claims 1 and 29, and claims 21-24, 26-28 and 30-33 dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 29, and claims 21-24, 26-28 and 30-33 dependent thereon, are indefinite in the recitation of "polypeptide encoded by SEQ ID NOS: . . .", because the SEQ ID NOS recited are amino acid sequences. Amendment of the claims to read "polypeptide having the amino acid sequence of any one of SEQ ID NOS: . . .", for example, at both occurrences  
5 would overcome the rejection.

Claims 24 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to seeds. However, there is no indication that the DNA construct transformed into the parent plant will be present in the  
10 claimed seeds or that the seeds would otherwise be distinguishable from seeds that would naturally occur.

The rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/244,205  
15 is withdrawn in view of the terminal disclaimer filed June 23, 2000 and further in view of the Power of Attorney filed November 11, 2000.

Claim 20 is in condition for allowance.

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-

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Art Unit 1638

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1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

10 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Elizabeth F. McElwain, Ph.D.  
February 9, 2001

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1600

*Elizabeth F. McElwain*